

REMARKS

In the Final Office Action¹ ("Office Action"), the Examiner took the following actions:

- (1) rejected claims 1, 14, 18, 20, 33 and 37 under 35 U.S.C. § 112, second paragraph;
- (2) rejected claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 101; and
- (3) rejected claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0092004 to Lee, et al. ("Lee").

By this amendment, Applicants propose to amend claims 1, 14, 18, 20, 33 and 37. Accordingly, claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 are pending in this application.

I. Rejection of claims under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the rejection of claims 1, 14, 18, 20, 33 and 37 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. The Office Action alleges that "[i]t is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed." Office Action, p.2. To expedite prosecution, Applicants have removed the recitation "for automatically generating a business software application," as recited in claim 1. A such, Applicants submit that claim 1 is definite and the rejection of the claim

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

should be withdrawn. Similar amendments are made to independent claims 14, 18, 20, 33, and 37, and the rejection of these claims should be withdrawn for at least the above reasons.

II. Rejection of claims under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action alleges that “[i]t is unclear if the software is present on the computer-platform or if the software is available externally to the computer platform claimed.” Office Action, p.4. This is incorrect. Applicants note that according to In re Bilski, “a claimed process is purely patent-eligible under §101 if (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” In re Bilski, 545 F.3d 943, at 954. Independent claim 1 recites “a central processing unit,” which includes statutory subject matter under In re Bilski. Independent claim 14 recites “steps [] performed by a computer,” which includes statutory subject matter under In re Bilski. Independent claim 18 recites “steps [] performed by a processor,” which includes statutory subject matter under In re Bilski. Independent claim 20 recites “a central processing unit,” which includes statutory subject matter under In re Bilski. Independent claim 33 recites “steps [] steps, executed by a computer,” which includes statutory subject matter under In re Bilski. Independent claim 37 recites “performed by a processor,” which includes statutory subject matter under In re Bilski. Accordingly, the rejection of claims 3-9, 12, 13, 17, 22-28, 30-32, 36, which

depend from the independent claims, are statutory at least due to their dependence, and the rejection of these dependent claims should be withdrawn.

III. Rejection of claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a), as being allegedly unpatentable over *Lee*. A *prima facie* case of obviousness has not been established with respect to any of these claims.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

For example, independent claim 1, recites "[a] passer element [that] processes ... data for input to said generating element." Further, independent claim 1 recites that the processing includes "interpreting ... said set of customized meta data" and "translating said ... data into customized business process data for input into said

generating element.” *Lee* fails to disclose or suggest at least these recited elements of independent claim 1.

The Office Action appears to allege that the generator program (28) of *Lee* is analogous to the claimed “passer element” while the “design program (26)” of *Lee* is analogous to the “generating element,” as recited in claim 1. Office Action, p. 18. Specifically, the Office Action states “the generator program (28), ... is the first tool, and design program (26), ... is the second tool.” *Id.* The Office Action is incorrect.

In *Lee*, “the design program 26 [is used] to create a system design for a new software application.” Paragraph [0035]. Specifically, in *Lee*, “the design program 26 prompts the designer for elements of the system design and stores those elements as a design database file 34 which is stored in the design database 30.” *Id.* Further, “the design database file 34 created by the design program 26 **is passed to the generator program 28** where it is reformatted as an extensible markup language (XML) meta document” (emphasis added). *Id.* That is, in *Lee*, generator program 28 merely receives processed information from design program 26. The generator program 28 of *Lee*, however, does not send any information to design program 26. As such, contrary to the Examiner’s allegation, the generator program 28 of *Lee* does not constitute the claimed “passer element,” which “processes ... **data for input to** design program 26,” as recited in claim 1 (emphasis added).

Additionally, as mentioned above, generator program 28 of *Lee* does not send but only receives information from the design program 26. Thus, Generator program 28 of *Lee* does not constitute the claimed “passer element,” which further “interpret[es] ...

said set of customized meta data" and "translat[es] said ... data into customized business process data **for input into said generating element**," as recited in claim 1 (emphasis added). Therefore, *Lee* does not teach or even suggest all of the elements of claim 1 for at least the above reasons.

In view of the mischaracterization of the prior art set forth above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Office Action has pointed out nothing in the prior art that would motivate one of skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of independent claim 1 under 35 U.S.C. § 103(a), as being obvious over *Lee*, is thus improper and should be withdrawn.

Further, independent claims 14, 18, 20, 33, 37, although differing in scope from independent claim 1, recite similar elements and are therefore allowable for at least reasons similar to those set forth above for independent claim 1. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of independent claims 14, 18, 20, 33, 37 under 35 U.S.C. § 103(a).

Claims 3-9, 12, 13, 17, 22-28, 30-32, and 36 depend from the independent claims. As such, these dependent claims are allowable for at least the reasons set forth above for the independent claims. Accordingly, Applicants respectfully request the

reconsideration and withdrawal of the rejection of these dependent claims under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this

Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

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By: _____



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